

**REMARKS**

Reconsideration of the rejections set forth in the Office Action mailed November 26, 2004, is respectfully requested. Claims 47 and 56 have been amended. Claims 47-63 remain pending in this case. Support for these amendments can be found in the specification at, e.g., page 3, lines 8-13; page 6, line 30 – page 7, line 7; page 8, lines 6-22; and Figs. 14-17.

Therefore, these amendments are made without the introduction of new matter.

**Art Rejections**

Claims 47-51 and 62 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Eggers et al. (USP 6,514,248). Claims 52-54 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Eggers et al. in view of Burbank et al. (USP 6,540,693). Claim 55 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Eggers et al. in view of Burbank et al., and further in view of Wilk et al. Independent claim 47 has been amended to include the step of “*initiating an electrosurgical arc*” before outwardly extending the elongate tissue separator element. None of the cited references teach or suggest such an arch initiation step.

Claims 55-63 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Eggers et al. in view of Burbank, et al., and further in view of Wilk et al. Claim 56 has been amended to specify that the tubular braided element is moved “*distally and longitudinally*” to an expanded state. Applicants respectfully assert that none of the cited references teach or suggest a device and method having an expandable tubular element longitudinally movable from a proximal, radially contracted state to a distal, radially expanded state. In particular, there is no motivation to combine these references. Eggers et al. teaches away from the use of a

longitudinally movable tubular element because it describes a membranous barrier that is moved circumferentially following the path of the electrode as it is rotated. “The structurally robust mounting of the electrode configuration also permits it to draw a membranous barrier shroud through the cut interface to carry out the noted additional isolation of targeted tissue.” (Col. 5, lines 61-64; see also Col. 30, lines 9-33) As seen in Figures 2, 3, 41-43, and accompanying text, in operation, the arch-shaped electrode of Eggers is pivoted “having a resultant circumscribing volume shape resembling a segment of an orange.” (Col. 5, lines 33-43) Therefore, the membranous barrier of Eggers would be moved circumferentially, not longitudinally, following the path of the electrode.

With respect to Wilk et al., applicants assert that there is no motivation to combine this reference with Eggers et al. Wilk et al. is from an unrelated filed in that it describes an assembly and procedure for removing polyps. The cutting device of Wilk et al. is very different than that described in Eggers, and these references are not properly combinable. In contrast to the arch-shaped electrode of Eggers that rotates circumferentially, Wilk et al. describes a cauterization loop that is placed over a polyp to be removed, electrical current is supplied to the loop, and the loop is closed (see Abstract). The web member is then opened and suction is applied through the tubular member to entrain the polyp to the web member (see Abstract). As such, a person of ordinary skill in the art would not have been motivated to combine the cutting device of Eggers et al. with the expandable tubular element of Wilk et al. Therefore, Applicants respectfully request withdrawal of the rejections and reconsideration of the claims as amended. Claims 57-63 are dependent on claim 56 and are therefore patentably distinct from the cited art for the same reasons cited above.

Therefore, applicants respectfully assert that the prior art does not teach or suggest each and every limitation of the claims as amended and request withdrawal of the rejections.

**CONCLUSION**

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,

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Dated: February 23, 2005

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